

PATENT

ATTORNEY DOCKET NO. 114595-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/611,548 Confirmation No.: 6763
Applicant: Douglas G. Lowenstein, et al.
Title: FINANCING OF TENANT IMPROVEMENTS
Filed: July 7, 2000 Art Unit: 3628
Atty. Docket: 114595-02 Examiner: Siegfried Chencinski

**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)
REQUESTING MAILING DATE OF APRIL 29, 2003**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that the attached

- Return postcard
- This Certificate of Mailing
- Information Disclosure Statement and Form PTO-1449
- 7 references

(along with any paper(s) referred to as being attached or enclosed) were originally deposited with the United States Postal Service on April 29, 2003 with sufficient postage as first-class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, and are being remailed today. These papers are entitled to entry as of April 29, 2003.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: November 8, 2004

By: David E. Boundy

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Douglas G. Lowenstein, et al.

Serial No.: 09/611,548

Filed: July 7, 2000

Examiner: Pedro Kanof

Art Unit: 3628

Title: FINANCING OF TENANT IMPROVEMENTS



I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on April 29, 2003 as First Class Mail in an envelope with sufficient postage addressed to The Commissioner for Patents, Box AF, Washington D.C. 20231.

David E. Boes

INFORMATION DISCLOSURE STATEMENT

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

1. In accordance with 37 C.F.R. §§ 1.56, 1.97 and 1.98, Applicant wishes to make of record the information set forth in paragraphs 2 through 6. In addition, Applicant wishes to make of record several items as listed on the accompanying Form PTO-1449. Applicant respectfully requests the Examiner to fully consider the information and items and independently ascertain their teaching before issuance of the next action, and to make them of record in the file. The Examiner is also requested to initial and return a copy of the enclosed Form PTO-1449 to evidence such consideration.

2. To the best of Applicants' knowledge, the items listed on the Form 1449 were not "published" within the meaning of § 102(b) before July 7, 1999, were not communicated to any party in a manner that would constitute a "commercial offer for sale," and were not communicated to any party in a manner that would constitute "public use."

3. Applicants' activities before July 7, 1999 did not rise to the level of a contractual offer for sale and thus cannot trigger a § 102(b) "on sale" bar. Before July 7, 1999 (the filing date of the provisional application from which this application claims priority):

- a. Applicants never entered discussions that included all parties necessary to formation of a contract that would fall within any claim of this application. For example, no discussion of the invention ever included both a landlord and a tenant.
- b. No party to any discussions proposed an offer containing a definite statement of all material terms, such as price or the time of performance.

- c. No party partially performed under any implied contract that would fall within any claim of the application.
- d. Applicants never communicated any manifestation of willingness to enter into a bargain, so made as to justify another person in understanding that his assent to that bargain is invited and will conclude it.

There was never an offer that another could have made into a binding contract by simple acceptance and consideration, and thus no "on sale" bar.

4. To Applicants' knowledge, there is no § 102(b) "public use" bar. To Applicants' knowledge, there was no actual use of the invention before July 7, 1999.

5. Applicants' activities before July 7, 1999 do not raise a § 102(b) "printed publication" bar. No documents describing the lease structure were made generally available to persons concerned with the art. All discussions with others that disclosed any details of the lease structure claimed in the application were under an explicit written non-disclosure agreement, or under the implicit confidentiality that accompanies the attorney-client or accountant-client relationship. Any presentation that was not under a formal written non-disclosure agreement was limited to a high-level, non-enabling discussion of the structure. No description of the structure that would allow one of skill in the art to reduce the invention to practice was ever made except under an explicit written non-disclosure agreement.

6. For purposes of examination, the Examiner may assume that documents 1-5 listed on the accompanying Form 1449 were disclosed before July 7, 1998, under the circumstances described in paragraphs 2 through 5 above.

7. Applicant reserves the right to establish the patentability of the claims over any information provided herewith, and/or to prove that this information may not be prior art. This Information Disclosure Statement should not be construed as a representation that information more material to the examination of this application does not exist.

8. This Information Disclosure Statement is being filed more than three months after filing of this application and after the mailing of a first Office Action on the merits, but before the mailing date of a final action under 37 C.F.R. § 1.113, or a Notice of Allowance under 37 C.F.R. § 1.311 (where there has been no prior final action), or an action that otherwise closes prosecution in the application. A fee is due pursuant to 37 C.F.R. § 1.97(c)(2).

9. The \$180.00 fee due under C.F.R. § 1.17 was paid with the Information Disclosure Statement filed March 31, 2003.

10. The Commissioner is hereby authorized to charge any additional fees that may be required for this Information Disclosure Statement, or credit any overpayment, to Deposit Account 50-0675, Order No. 57634.3.

Respectfully submitted,

SCHULTE ROTH & ZABEL, LLP

Dated: April 29, 2003

By: 

David E. Boundy

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FORM PTO-1449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTORNEY DOCKET NO. 57634.3		SERIAL NO. 09/611,548	
INFORMATION DISCLOSURE CITATION (Use several sheets if necessary)				APPLICANT Douglas G. Lowenstein, et al.		FILING DATE July 7, 2000	
				GROUP ART UNIT 3628			

U.S. PATENT DOCUMENTS							
EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE	

FOREIGN PATENT DOCUMENTS							
DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION		
					YES	NO	

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Papers, Etc.)		
1		DGL Capital Corporation (predecessor to Polestar Capital Partners) and Shearman & Sterling, SYNTHETIC LEASE FINANCING OF TENANT IMPROVEMENTS, unpublished attorney-client working paper (undated)
2		Polestar Capital Partners, LLC, INVESTMENT PROPOSAL, SYNTHETIC LEASE FINANCING OF TENANT IMPROVEMENTS, unpublished confidential presentation (undated)
3		Polestar Capital Partners, LLC, PRESENTATION TO XYZ COMPANY REGARDING FINANCING OF LEASEHOLD IMPROVEMENTS, unpublished confidential presentation (undated)
4		Polestar Capital Partners, LLC, CREDIT-BASED LEASE FINANCING OF TENANT IMPROVEMENTS, unpublished confidential presentation (undated)
5		Polestar Capital Partners, OVERVIEW OF LEASEHOLD IMPROVEMENT FINANCING, unpublished confidential presentation (undated)
6		Polestar Capital Partners and Merrill Lynch & Co., GENERALLY ACCEPTED ACCOUNTING PRINCIPLES FOR TWO HYPOTHETICAL LEASE TRANSACTIONS, unpublished confidential accountant-client working paper (May 14, 1999)
7		Polestar Capital Partners, LEASE, unpublished confidential draft (June 30, 1999)

EXAMINER	DATE CONSIDERED
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